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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/987,931 | 11/16/2001 | Kevin Qun Fang | 4821-439-999 | 7960 |

20582 7590 03/01/2006

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| EXAMINER | |
|---|---|
| KIM, VICKIE Y | |
| **ART UNIT** | **PAPER NUMBER** |
| 1618 | |

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Advisory Action Before the Filing of an Appeal Brief | Application No. 09/987,931 | Applicant(s) FANG ET AL. | |
|---|---|---|---|
| | Examiner Vickie Kim | Art Unit 1618 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED 18 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *127-132*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

VICKIE KIM
PRIMARY EXAMINER

Vickie Kim
Primary Examiner
Art Unit: 1618

Continuation of 11. does NOT place the application in condition for allowance because: The claim 127 drawn to a method of treating an affective disorder using an effective amount of bupropion metabolite(i.e. (+)-(2S, 3S)-2-(3-chlorophenyl)-3,5,5-trimethyl-2-morpholinol) ,which is adjunctively administered with a therapeutically effective amount of a second pharmacologically effective compound.
Applicant argued that Moargan et al's references fail to anticipate the instant claims 127-130 because Morgan et al's references fails to teach second active agent . This examiner disagrees. Firstly of all, the claim is broadly drafted and allpicant fail to specify the purpose of using secondary active agent. Because the claims are only requiring a therapeutically effective amont of second active agent but failt to limit the specific therapeutic utility second agent must have. Thus, the teaching of Morgan et al's patents embraces the scope of the instant claims 127-130 and thus anticipate the claims. The instant claims fails to recited specific class or agent, rather they simply require that the second active agent used is a compound in the amount of therapeutically effective. For example US'579 teaches use of (+)-(2S, 3S)-2-(3-chlorophenyl)-3,5,5-trimethyl-2-morpholinol and tetrabenazine in vivo model, see col.7, lines 38-col.8, lines 20. The therapeutically effective amount of pharmacologically active Tetrabenazine is used to induce behavior-depression and administration of (+)-(2S, 3S)-2-(3-chlorophenyl)-3,5,5-trimethyl-2-morpholinol has followed to treat depression induced by Tetrabenazine. US 2003/0064988 (Morgan et al) also teaches second active ingredients such as antidiabetic agent or antidepressants, see page 2, paragraph 20. The claims are not specific enough to exclude any second active agent having therapeutically effective amount for its own use. Thus, 102 rejection is maintained.
For 103 rejection, after careful consideration of applicant's remarks , the conventional knowledge available in the field at the time of the invetion was filed(see Howard's patent(US6410736 or 6677378) or Cary(WO 99/17803, or other documents enclosed in PTO-892)) in view of Morgan et al's teaching in their patents renders the claimed subject matter (i..e. combination drug therapy ispecially with active bupropion metabolite such as US 2003/0064988 (Morgan et al) also teaches second active ingredients such as (+)-(2S, 3S)-2-(3-chlorophenyl)-3,5,5-trimethyl-2-morpholinol and secondary active agent , espeically one selected from selective serotoin reuptake inhibitor(SSRI), 5-HT3inhibitor or nicotine) obvious and not patentably distinct over the prior art of the record. Unless the claimed subject matter(i.e. a combinaiton of pupropion metabolit and second active agent) has unpextected result which has not been taught or discovered in the field at the time of the invetion was filed,all the claims are maintained for the reasons mentioned above and the detailed in previous office action.